



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,277	01/19/2001	Robert K. Samson	3986-4001	9675
27123	7590	07/12/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			FELTEN, DANIEL S	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,277

Applicant(s)

SAMSON, ROBERT K.

Examiner

Daniel S. Felten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/26/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on April 26, 2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. The body of the claim recite technology. If the invention in the body of the claim is not tied to technological art, environment or machine, the claim is not statutory the recitation in the body of independent claims 1, 21, 32, 41, 51, 71, 87 are directed to merely human mental computation and/or processes that can be performed by a person manually and thus considered nothing more than an abstract idea as contemplated by the Constitution [see Ex Parte Bowman, 61 USPQ 2d. 1665, 1671 (BD Pat. App & Inter 2001) (Unpublished)]*. Also note MPEP 2106 IV 2(b).

- Even though Bowman is not precedential, it can be cited for its analysis

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-11, 13-18, 21-61, 63-69, 71-91, 94-102 and 106-112 rejected under 35

U.S.C. 102(e) as being anticipated by Giansante et al (US 6,275,814)

Re claims 1, 21,24, 41, 51, 71,74, 87-91, 95, 98, 99, 106-112, Giansante discloses an investment Guidance system, a method for rating assets (see Giansante, Abstract, col. 2, ll. 29-61),

Receiving/transmitting a request to rate plurality of said assets (see col. 2, ll. 37-39),

Providing two or more criteria associated with said assets for a user to evaluate (see col. 2, ll. 40-44),

Receiving a relative weight of importance for said two or more criteria based on the user's personal investment preferences (see *investment styles*, col. 2, ll. 45-51; col. 5, ll. 14-19), and

Determining a rating for each asset (*portfolio*) based on the relative weights assigned to said two or more criteria (see col. 2, ll. 36-39; and col. 6, ll. 36-41),

Art Unit: 3624

Re claims 2, 22, 52, 72, ranking plurality of said assets based on rating (see col. 2, ll. 36-39; col. 5, ll. 14-19 and col. 6, ll. 36-41),

Re claim 25, wherein one or more of the input mechanisms are graphical input devices (see *Browser*, col. 5, ll. 48+),

Re claims 3, 100, providing a list of ranked assets (see figs. 4, 5, col. 4, ll. 27+),

Re claims 4, wherein said criteria are measured by one or more statistical parameters (see col. 2, ll. 31-34),

Re claims 5, 73, receiving a request to execute a trade for one or more of the assets; and Executing said trade for one or more of the ranked assets (see col. 5, ll. 5+),

Re claims 6-9, 26-29, 56-59, wherein the assets are mutual funds, stocks, bonds, securities (see col. 2, ll. 52-61),

Re claims 10, 30, 60, wherein assets are categorized by class (see *diversification*, col. 2, ll. 40-44),

Re claims 11, 31, 61, wherein asset class is at least one of US equities, international equities, fixed income, or any sub-set class thereof real estate, precious metals, cash (see col. 2, ll. 52-61),

Re claims 13, 62, 63, wherein one of said criteria is consistent returns (see col. 5, ll. 6-10)

Re claims 14, 64, wherein one of said criteria is stock/bond picking (see col. 4, ll. 57+)

Re claims 15, 65, wherein one criteria is low risk (see col. 3, ll. 18-34; and col. 5, ll. 6-10)

Re claims 16, 66, wherein one of said criteria is consistent investment style (see col. 2, ll. 45-51; col. 5, ll. 14-19)

Art Unit: 3624

Re claims 17, 67, wherein one of said criteria is low fees (see *fund expenses*, col. 6, ll. 61)

Re claims 18, 68, further comprising providing an input mechanism for receiving the relative weight of importance for said asset criteria (see col. 2, ll. 36-39; col. 6, ll. 36-41)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12, 19, 20, 62, 70, 92, 93 and 103-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giansante et al (US 6,275,814)

Giansante fails to disclose, as in claim 12, 62, wherein one of said criteria is tax efficiency. Since the amount of tax impact upon a portfolio may have a significant impact upon total returns, it would have been obvious for an artisan of ordinary skill in the art at the time of the invention to provide tax efficiency as a criteria in consideration of portfolios that would lie within an efficient “zone” to create weighted a set of weighted average portfolios. Thus such a modification would have been an obvious expedient well within the ordinary skill of the art.

Giansante fails to disclose, as in claims 19, 20, 69, 70, wherein one or more of the input mechanisms are slider bars or text boxes. Giansante does disclose a browser application which may include the aforementioned features (see col. 5, ll. 48+). It would have been obvious for an artisan of ordinary skill in the art to employ the notoriously old and well known slider bars and text boxes within a browser application because such features would allow the user to interact with data by scrolling information within the browser window and or input data to the webpage via a browser. Thus an artisan would find such features convenient by allowing greater interactivity between the user and the invention.

Giansante, as in claims 92, 93, and 103-105 fails to disclose having an executable software code, per se, however, it would have been obvious for an artisan of ordinary skill in the art to recognize the use of Excel spreadsheet (see col. 4, ll. 51-56), as software that can be made executable by the implementation of the invention's methodology in the software, and as contemplated by Giansante. Thus such a modification would be considered obvious to one of ordinary skill in the art.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patents:

Wallman (US 6,338,047) discloses a method and system for investing in a group of investments that are selected based on the aggregated individual preference of plural investors

Wallman (US 6,601,044) discloses a method and apparatus for enabling individuals or smaller investors

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (703) 305-0724.

The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF
June 23, 2005

Daniel S Felten
Examiner
Art Unit 3624

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

